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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/653,555	09/01/2000	William O. Mattick	P_3009.002 Ames	5462
23399	7590	06/15/2005	EXAMINER	
REISING, ETHINGTON, BARNES, KISSELLE, P.C.			SMITH, JEFFREY A	
P O BOX 4390			ART UNIT	
TROY, MI 48099-4390			PAPER NUMBER	
			3625	

DATE MAILED: 06/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/653,555	Applicant(s) MATTICK ET AL.	
	Examiner Jeffrey A. Smith	Art Unit 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 January 2005 and 07 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-57 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-57 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 1/27/05 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

[Handwritten signature]

Art Unit: 3625

DETAILED ACTION

Response to Amendment

The responses filed January 27, 2005 and February 7, 2005 has been entered and considered.

The substitute Specification and Abstract filed January 27, 2005 have been approved.

The Replacement Pages of Drawings filed January 27, 2005 have been approved.

The listing of the claims filed February 7, 2005 has been entered and supersedes all previous versions. Claims 1-14 have been cancelled. Claims 15-57 are pending. An action on the merits of claims 15-57 follows.

Declarations under 37 CFR 1.132

The Declarations under 37 CFR 1.132 filed January 27, 2005 are moot in view of Applicant's amendments to claims 15 and 45 deleting the step of estimating said forecasts.

Art Unit: 3625

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 15-57 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970).

Art Unit: 3625

Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).

This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson*, 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue

Art Unit: 3625

of the "technological arts". The court developed a "technological arts" analysis:

The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. *In re Toma* at 857.

In *Toma*, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.

The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.*, the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See *State Street Bank & Trust Co.* at 1374. Furthermore, the court found that there was no

Art Unit: 3625

"business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under §101, but rather under §§102, 103 and 112." See *State Street Bank & Trust Co.* at 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, *State Street* abolished the Freeman-Walter-Abele test used in *Toma*. However, *State Street* never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the invention in *State Street* (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the *Toma* test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in affirming a §101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

An analysis of the instant claims follows:

Art Unit: 3625

First prong

The claims, as amended to recite (as in claim 45, for example) "a data processing method for converting environmental performance data into meaningful and readily understandable information for use by consumers as an aid in their selection of a product or service for purchase and by businesses to facilitate awareness and consideration of their products or services through advertising", provide a useful, concrete, and tangible result.

Second prong

The claims do not involve a specific application of technology in any non-trivial manner.

Although the claims recite technology, such technology is not applied in the method steps in a specific and non-trivial manner.

Claims 15 and 45 recite "establishing an Internet web site". The mere establishment of an Internet web site is tantamount to a step of merely providing an Internet web site. Although an Internet web site invokes some semblance of "technology", the mere establishment or provision of a "technology" does not move to invoke an implementation of such technology in the method in any specific and non-trivial manner.

Art Unit: 3625

This is because there is no recitation that the web site itself serves to specifically act on any other "technology" or specifically effect any other manipulative step in any non-trivial manner.

Claims 15 and 45 additionally recite "using said Internet web site to communicate said awards to said consumers for their vehicle purchasing decisions". The recitation that the "technology" (i.e. the web site) is "[used]" does not move to impart any specific application of the web site in communicating information to the consumers. Moreover, this recitation otherwise amounts to the mere communication of some form of information to consumers. Such communication is considered a trivial application of "technology". This is because the information communicated is merely transferred from said web site to said consumers. The step of communicating such information does not otherwise involve a non-trivial application of the web site in the handling or management of the information forming the subject of the communication. Similar recitations in claims 44, and 57, are noted and are held to amount to trivial involvement of technology for the reasons stated above.

Absent any specific and non-trivial application of technology, the methods recited merely set forth an abstract idea which is held to be ineligible subject matter under 35 USC

Art Unit: 3625

101. Other steps recited in the claims involve no specific application of technology which would serve to convert the otherwise ineligible subject matter to eligible subject matter. Such other steps include data collection, data sorting, and data manipulation. Such steps remain as mental contrivances which are not recited as being specifically performed by any form of "technology".

Allowable Subject Matter

Claims 15-57 are allowable over the prior art of record.

Response to Arguments

Applicant's arguments filed January 27, 2005 have been fully considered but they are not persuasive.

The only issue that remains is whether the claims recite a specific and non-trivial application of "technology" (see discussion above).

Applicant remarks that "claims 15 and 45 recite data processing methods for converting data in a relatively complex and useless form to consumers, to valuable information that is meaningful and readily understandable to consumers".

Art Unit: 3625

The Examiner notes that this remark (and other similar remarks at pages 23 and 24) is persuasive for the purposes of defending the claims in light of the first prong of the test (i.e. that the claimed subject matter provides a useful, concrete and tangible result), however, this remark is not persuasive for the purposes of defending the claims in light of the second prong of the test (i.e. that the claims recite a specific and non-trivial application of "technology"). Moreover, the recitation that the methods are "data processing" methods do not invoke any specific and non-trivial application of "technology". For example, "data processing" of the type that involves only mental calculation involves the application of no technology.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will

Art Unit: 3625

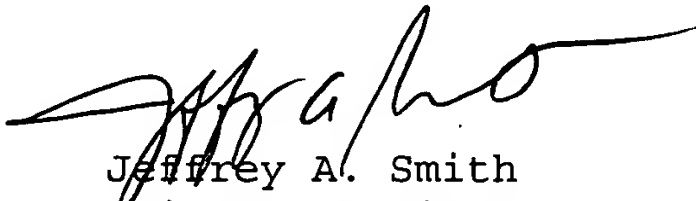
expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Art Unit: 3625

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey A. Smith whose telephone number is (571) 272-6763. The examiner can normally be reached on M-F 6:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on (571) 272-7159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jeffrey A. Smith
Primary Examiner
Art Unit 3625

jas

Replacement
Pages filed 1/27/05

approved 6/6/05

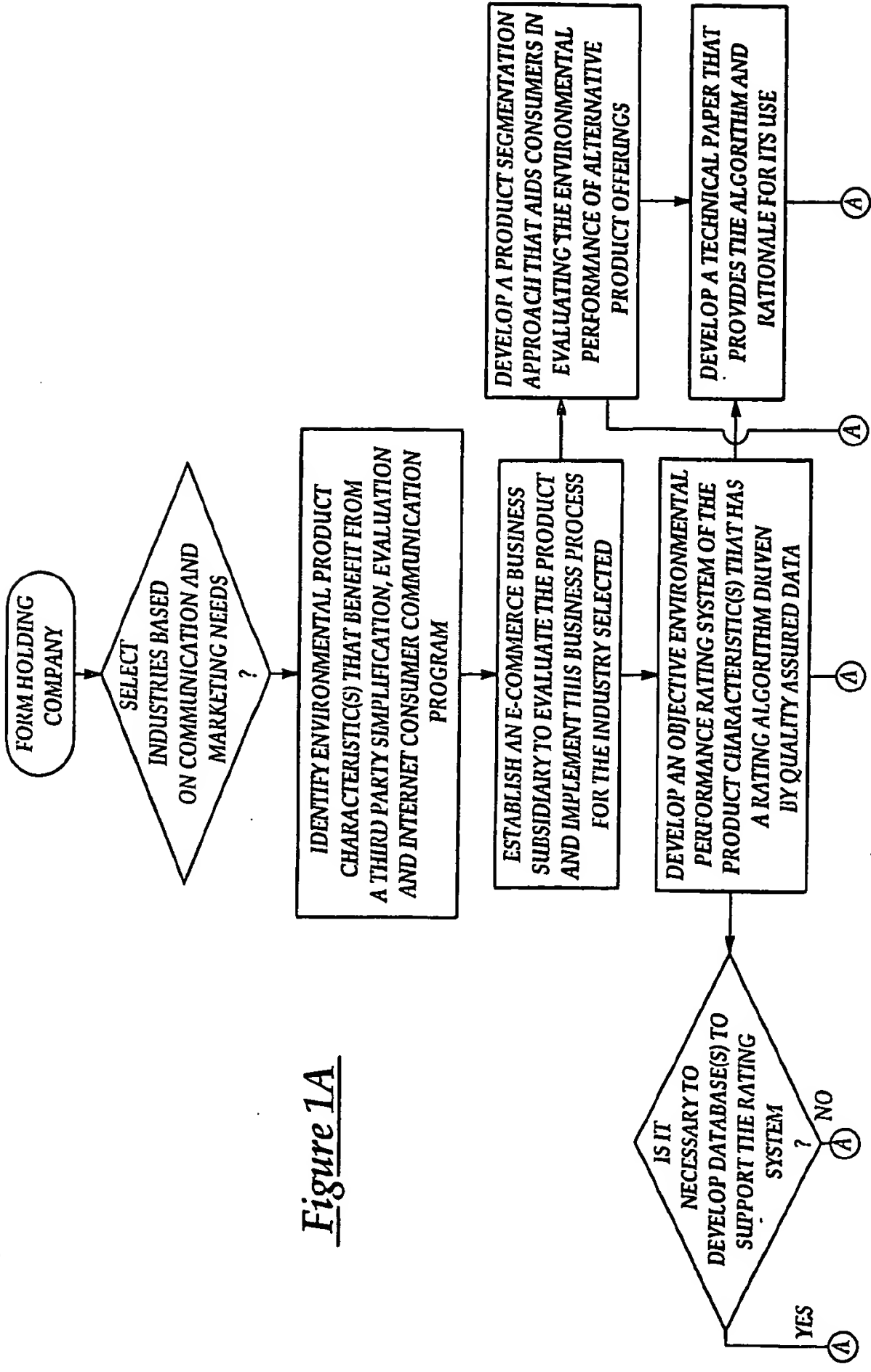


Figure 1A